

**REMARKS**

This amendment is in response to the Office Action of October 19, 2005.

Claims 1 through 22 are currently pending in the application.

Claims 3 through 22 have been amended herein to reorder the claims as requested by the Examiner. No substantive changes have been made to the text of the claims. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are made without prejudice or disclaimer.

**Claim Objections**

Claims 20, 21, and 22 are objected to due to claim order. Appropriate correction has been made.

**35 U.S.C. § 102(e) Anticipation Rejections**

**Anticipation Rejection Based on Cooper *et al.* (U.S. Patent 6,816,270)**

Claims 18 and 19 (now claims 21 and 22) were rejected under 35 U.S.C. § 102(e) as being anticipated by Cooper *et al.* (U.S. Patent 6,816,270) (hereinafter “Cooper”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 21 (formerly claim 18) recites a system for optimizing the use of printing devices on a network computer system, comprising . . . a computer connected to the network computer system, and a computer program for optimizing the use of at least one printing device accessible to the computer.

Applicant asserts that Cooper does not identically describe, either expressly or inherently, each and every element of claim 21 in as complete detail as contained in the claim to anticipate the claimed invention under 35 U.S.C. § 102. Applicant submits that Cooper does not describe the element of the claimed invention calling for “a computer program for optimizing the use of at least one printing device accessible to said computer.” Cooper does

not describe optimizing the use of at least one printing device. Cooper describes “a method, apparatus, and instructions for providing functions, such as, for example, print preview support that is independent of the particular application or printer device driver.” *Column 2, lines 33-37*. Cooper describes providing software simulation when a print option is not supported by hardware. *Column 7, lines 47-48*. Software simulation is not optimizing the use of a printing device. Cooper does not describe expressly or inherently that software simulation is optimizing the use of a printing device. Therefore, for at least this reason, Cooper does not anticipate claim 21 (formerly claim 18) under 35 U.S.C. § 102, and independent claim 21 (formerly claim 18) is allowable.

Claim 22 (formerly claim 19) is allowable for at least the reason of depending from allowable independent claim 21 (formerly claim 18).

### **35 U.S.C. § 103(a) Obviousness Rejections**

#### **Obviousness Rejection Based on Cooper and Igval (U.S. Patent 6,045,206)**

Claims 1 through 6, 20, and 21 (now claims 1 through 7 and 14) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval (U.S. Patent 6,045,206) (hereinafter “Igval”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant further submits that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure.

Independent claim 1 recites a method for improving the use of printing devices in a network computer system, comprising . . . determining the usage characteristics of at least one printing device, determining the options available for each of the at least one printing devices, determining any installed options currently existing on the at least one printing device, and determining a way to optimize the at least one printing device from the usage characteristics, the available options and the installed options.

The Examiner asserted that Cooper discloses determining a way to optimize the at least one printing device from the available options and the installed options. *Office Action of October 19, 2005., p. 3.* The Examiner asserted Igval discloses determining a way to optimize the at least one printing device from the usage characteristics. *Office Action of October 19, 2005., p. 4.*

Applicant asserts that Cooper and Igval, even if combined, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant submits that Cooper does not teach the element of the claimed invention calling for “determining a way to optimize said at least one printing device from said usage characteristics, said available options and said installed options.” Cooper teaches “a method, apparatus, and instructions for providing functions, such as, for example, print preview support that is independent of the particular application or printer device driver.” *Column 2, lines 33-37.* Cooper teaches providing software simulation when a print option is not supported by hardware. *Column 7, lines 47-48.* That is not determining a set of optimal options for a printing device. Determining optimal options requires evaluating options. Cooper, and the other cited references, do not teach or suggest such evaluation. The cited references do not teach or suggest determining a set of optimal options for a printing device. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established. Therefore, independent claim 1 is allowable.

Claims 2 through 7 and 14 (formerly claims 2 through 6, 20, and 21) are allowable for at least the reason of depending from allowable independent claim 1.

Claim 2 is further allowable since neither Cooper nor Igval teach or suggest suggesting at least one change at least one change to an at least one printing device for optimizing the use of the at least one printing device with a network computer system.

Claim 3 (formerly claim 20) is additionally allowable for depending from claim 2 and further allowable since neither Cooper nor Igval teach or suggest suggesting at least one change to an at least one printing device for optimizing the use of the at least one printing device with a network computer system comprising suggesting an option selected from the group consisting of using a toner miser function, turning on a job retention memory, and suggesting other printing device configurations.

Claim 14 (formerly claim 21) is further allowable since neither Cooper nor Igval teach or suggest suggesting at least one service to incorporate with an at least one printing device for providing enhanced usage of the at least one printing device.

Obviousness Rejection Based on Cooper and Igval as applied to claim 1, and in further view of Parulski (U.S. Patent 6,915,273)

Claims 7 and 10 (now claims 8 and 11) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval as applied to claim 1, and in further view of Parulski (U.S. Patent 6,915,273) (hereinafter "Parulski"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claims 8 and 11 (formerly claims 7 and 10), Applicant asserts that Cooper, Igval, and Parulski, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, independent claim 1 is allowable. Claims 8 and 11 (formerly claims 7 and 10) are allowable for at least the reason of depending from allowable independent claim 1.

Obviousness Rejection Based on Cooper and Igval as applied to claim 1, and in further view of Allen *et al.* (U.S. Patent 4,556,959)

Claims 8 and 11 (now claims 9 and 12) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval as applied to claim 1, and in further view of Allen *et al.* (U.S. Patent 4,556,959) (hereinafter "Allen"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claims 9 and 12 (formerly claims 8 and 11), Applicant asserts that Cooper, Igval, and Allen, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, independent claim 1 is allowable. Claims 9 and 12 (formerly claims 8 and 11) are allowable for at least the reason of depending from allowable independent claim 1.

Obviousness Rejection Based on Cooper and Igval as applied to claim 1, and in further view of Wood *et al.* (U.S. Patent 6,453,127)

Claim 9 (now claim 10) is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval as applied to claim 1, and in further view of Wood *et al.* (U.S. Patent 6,453,127) (hereinafter “Wood”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 10 (formerly claim 9), Applicant asserts that Cooper, Igval, and Wood, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, independent claim 1 is allowable. Claim 10 (formerly claim 9) is allowable for at least the reason of depending from allowable independent claim 1.

Obviousness Rejection Based on Cooper and Igval as applied to claim 1, and in further view of Hopkins (U.S. Patent 5,390,004)

Claim 12 (now claim 13) is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval as applied to claim 1, and in further view of Hopkins (U.S. Patent 5,390,004) (hereinafter “Hopkins”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 13 (formerly claim 12), Applicant asserts that Cooper, Igval, and Hopkins, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, independent claim 1 is allowable. Claim 13 (formerly claim 12) is allowable for at least the reason of depending from allowable independent claim 1.

Obviousness Rejection Based on Cooper and Igval and Dewitt *et al.* (U.S. Patent 5,572,672)

Claims 13 and 15 through 17 (now claims 16 and 18 through 20) are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval and Dewitt *et al.* (U.S. Patent 5,572,672) (hereinafter “DeWitt”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Independent claim 16 (formerly claim 13) recites a method for suggesting printing device options in a network computer system, comprising . . . operating a device management program on a computer connected to a network communication, determining the usage characteristics of at least one printing device with the device management program, operating a computer program on the computer, using the computer program to determine the options available for the at least one printing device, using the computer program to determine any installed options on the at least one printing device, and using the computer program to determine an optimal set of options for the printing device.

The Examiner asserted that Cooper discloses using the computer program to determine an optimal set of options for the printing device. *Office Action of October 19, 2005., p. 9.*

Applicant asserts that Cooper, Igval, and DeWitt, even if combined, do not teach or suggest all of the claim limitations of independent claim 16 (formerly claim 13) to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant submits that Cooper does not teach the element of the claimed invention calling for “using said computer program to determine an optimal set of options for said printing device.” Cooper teaches “a method, apparatus, and instructions for providing functions, such as, for example, print preview support that is independent of the particular application or printer device driver.” *Column 2, lines 33-37.* Cooper teaches providing software simulation when a print option is not supported by hardware. *Column 7, lines 47-48.* That is not determining a set of optimal options for a printing device. Determining optimal options requires evaluating options. Cooper, and the other cited references, do not teach or suggest such evaluation. The cited references do not teach or suggest determining a set of optimal options for a printing device. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established. Therefore, independent claim 16 (formerly claim 13) is allowable.

Claims 18 through 20 (formerly claims 15 through 17) are allowable for at least the reason of depending from allowable independent claim 16 (formerly claim 13).

Claim 20 (formerly claim 17) is further allowable since neither Cooper, Igval, nor DeWitt teach or suggest using a computer program to determine an optimal set of options for

a printing device comprises using the computer program to compare installed options with available options.

Obviousness Rejection Based on Cooper and Igval, and Dewitt as applied to claim 13, and in further view of Wood

Claim 14 (now claim 17) is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval, and Dewitt as applied to claim 13 (now claim 16), and in further view of Wood. Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 17 (formerly claim 14), Applicant asserts that Cooper, Igval, DeWitt, and Wood, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 16 (formerly claim 13) to establish a *prima facie* case of obviousness regarding the invention of claim 16 (formerly claim 13) under 35 U.S.C. § 103. Therefore, independent claim 16 (formerly claim 13) is allowable. Claim 17 (formerly claim 14) is allowable for at least the reason of depending from allowable independent claim 16 (formerly claim 13).

Obviousness Rejection Based on Cooper and Igval as applied to claim 21, and in further view of Hanzawa (U.S. Patent 5,506,661)

Claim 22 (now claim 15) is rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper and Igval as applied to claim 21 (now claim 14), and in further view of Hanzawa (U.S. Patent 5,506,661) (hereinafter "Hanzawa"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Regarding claim 15 (formerly claim 22), Applicant asserts that Cooper, Igval, and Hanzawa, assuming combinability *arguendo*, do not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the invention of claim 1 under 35 U.S.C. § 103. Therefore, independent claim 1 is allowable. Claim 15 (formerly claim 22) is allowable for at least the reason of depending from claim 14 (formerly claim 21) which depends from independent claim 1.

Applicant submits that claims 1 through 22 are clearly allowable over the cited prior art.

Serial No. 10/092,050

Applicant requests the allowance of claims 1 through 22 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan".

James R. Duzan  
Registration No. 28,393  
Attorney for Applicant  
TRASKBRITT, P.C.  
P.O. Box 2550  
Salt Lake City, Utah 84110-2550  
Telephone: 801-532-1922

Date: January 9, 2006  
JRD/dlm:lmh

Document in ProLaw